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IFW

Docket No. 1232-5182

Applicant(s): Tsutomu Honma et al.

Group Art Unit: 1651

Serial No.: 10/692,206

Examiner: Herbert J. Lilling

Filed: October 22, 2003

For: POLYHYDROXYALKANOATE CONTAINING UNIT HAVING CYCLOHEXYL
STRUCTURE AT SIDE CHAIN, PRODUCTION PROCESS THEREFOR, AND
BINDER RESIN CONTAINING POLYHYDROXYALKANOATE

EXPRESS MAIL CERTIFICATE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Express Mail Label No.: EV 826 874 263 US

Date of Deposit: April 7, 2006

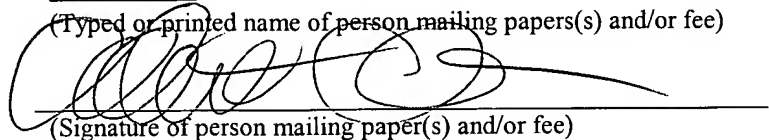
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1. Response to Restriction Requirement - 3 pages (in duplicate)
2. Postcard for Receipt Acknowledgement

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Albert Isles

(Typed or printed name of person mailing papers(s) and/or fee)



(Signature of person mailing paper(s) and/or fee)

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PATENT



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
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Sirs:

The Office Action mailed on March 7, 2006 provides that restriction to one of the following inventions is required under 35 U.S.C. §121:

Group I "Claims 1 and 3-4, drawn to a polyhydroxyalkanoate having the formula 1, classified in class 528, subclass 271+."

Group II "Claim 2, drawn to a co polymeric composition containing an additional unit as represented by formulas 1-15, classified in class 528, subclasses numerous depending upon the monomeric units 1-15 which includes 176."

Group III "Claims 5-9, drawn to a process for the production of formula 1 by culturing a microorganism, classified in class 435, subclass 135."

Group IV "Claims 10-15, drawn to a binder resin composition, classified in numerous classes depending upon the resin components which includes at least one of polycaprolactone and a polylactic acid classified in numerous classes."

Group V "Claim 16, drawn to an electrostatic charge image-developing toner, classified in class 430, subclass 109.1"

Group VI "Claim 17, drawn to an image-forming method, classified in class 430, subclass 127."

Group VII "Claim 18, drawn to an image-forming apparatus, classified in class 399, subclass 159."

Applicant provisionally elects for prosecution the invention of Group I (Claims 1 and 3-4). Applicant believes that the restriction requirement is improper and therefore makes the above election with traverse.

Applicant respectfully submits that for a restriction requirement to be proper, MPEP §803, is clear that "there are two criteria for restriction between patentably distinct inventions" as follows:

- "(1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required" (emphasis added)

Applicant respectfully submits that: all groups of restricted claims are properly presented in the same application; undue diverse searching would not be required; and all claims should be examined together. Accordingly, examination of the claims of Groups II-VII, in addition to the claims of Group I, would place no additional "serious" burden on the Examiner as examination of the claims of Groups II-VII would not require undue diverse searching beyond that which would be necessary for examination of the claims of Group I.

Applicant respectfully submits that the claims of Groups II-IV should be examined on the merits as well.

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For the foregoing reasons, it is respectfully submitted that the restriction requirement should be withdrawn and an action on the merits of all the claims is respectfully requested.

AUTHORIZATION


No fees are believed necessary in connection with this response. While Applicant believes no extension of time to be necessary for this response, should an extension of time be required, such extension is respectfully petitioned. The Commissioner is authorized to charge any fees or credit any overpayments which may be required for this paper to Deposit Account Number 13-4500, Order No. 1232-5182. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: April 7, 2006

By:


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